

**REMARKS**

Claims 10-29 are pending in the application. Claims 10, 14, 17, 19 and 23 have been amended. Applicant respectfully requests reconsideration of the application in view of the following remarks.

Claims 10-29 have been rejected under 35 U.S.C. § 112 (first paragraph) as failing to comply with the written description requirement. Although Applicant cannot agree with the (unproven) contention that claims 10-29 as written do not find adequate support in the original disclosure as filed, in order to expedite prosecution of this application, Applicant has removed the phrase “wherein the received response is not predetermined by the interview system,” as recited in claim 10, and similarly recited in claims 17 and 23. Applicant respectfully submits that no change in scope has been made from this amendment because the phrase is inherent in the term “interview” as properly construed in light of the original disclosure.

Nevertheless, Applicant respectfully submits that the rejection of claims 10-29 under 35 U.S.C. § 112 has been rendered moot and respectfully requests that the rejection be withdrawn.

Claims 10-16 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection and requests reconsideration because nothing in the subject matter recited in claims 10-16 is “non-statutory.”

In particular, the Office Action states: “A method of conducting an interview as presented in claim 1 is non-statutory as not being tangible. The claims should be amended to include a tangible embodiment or implementation.” Office Action at 3. It is not clear from the Office Action, however, what is meant by the term “tangible.” Nor

is it clear where in any statutory or other authority is there any requirement that a “method” or process-type invention be “tangible.”

Under 35 U.S.C. § 101, the only limitations to subject matter that may be patentable are: printed matter; naturally occurring articles; and scientific principles, as indicated in the Manual of Patent Examining Procedure (M.P.E.P.) (Section 706.03 (a) Rejections Under 35 U.S.C. § 101). Nothing in that M.P.E.P. section states or even suggests that a claimed method must be “tangible” in order to qualify as statutory subject matter. Nor does anything in that section (or anything cited in the Office Action) establish that the Applicant’s invention as recited in claims 10-16 falls under the categories of non-statutory subject matter identified in the M.P.E.P.

The U.S. Patent and Trademark Office “bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. . . . If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Indeed, in this case, the Office Action violates 35 U.S.C. § 132.<sup>1</sup> As in Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990), for example, the rejection violates Section 132 because it is “so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”

Applicant therefore respectfully requests that the rejection be withdrawn, or a new, non-final Office Action be issued detailing the exact nature (and underlying

---

<sup>1</sup> 35 U.S.C. § 132 states: “Whenever, on examination, any claim for a patent is rejected, . . . the Director shall notify the applicant thereof, stating the reasons for such rejection, . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.”

authority) for any finding that a non-tangible method claim is unpatentable under 35 U.S.C. § 101.

Claims 10-12 and 17-22 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,268,849 (Boyer et al.). Applicant respectfully traverses this rejection and requests reconsideration because nothing in Boyer et al. anticipates the subject matter claimed.

Boyer et al. is merely directed to a system for providing television program listings for viewers. Boyer et al. allows a potential viewer to access over the Internet the television program listings for any cable or satellite provider stored in its data server (Figure 1). The “interview questions” presented in Boyer et al. that are asserted in the Office Action (at 3) as meeting the “interview” limitations (of claim 10, for example) are nothing more than prompts to assist a user in finding a local cable provider or national satellite provider. See, e.g., column 6, line 47 to column 7, line 40 (describing a user input of a zip code or selection of a state and region within a state to find a cable system operator operating in the selected region). Even if it is assumed that these prompts can be relied upon as an “interview” system,<sup>2</sup> Boyer et al. fails to disclose (or render obvious) anything that operates to perform the step of “geocoding the location input received” from the viewer when the viewer is selecting a desired cable system operator (or other television provider). Indeed, because the system in Boyer et al. is simply used to provide television program listings for specific cable providers, Boyer et al. has no use for geocoding any location input from a user, as required in claim 10. Nor does Boyer et al. have any need to store the location input or the geocoded representation of the location input, as required in claim 14.

---

<sup>2</sup> Applicant reserves the right to contest the assertion of an “interview system” in Boyer et al., as well as the right to predate Boyer et al. with evidence that Applicant’s invention was made prior to the filing of Boyer et al.

Similar limitations appear in independent claim 17. Claim 17, for example, recites an “article of manufacture” that has a control program that includes the step of “geocoding the location response, and storing the geocoded location response.” As nothing in Boyer et al. discloses (or renders obvious) anything that operates to perform geocoding and storing of a location response, as recited in claim 17, Applicant respectfully submits that the rejection of claim 17 is in error and should be withdrawn for the same reasons given above with respect to claim 10.

For at least these reasons, Applicant respectfully submits that the rejection of claims 10 and 17 is in error and should be withdrawn. As dependent claims 11-12 and 18-22 incorporate the limitations of independent claims 10 and 17, respectively, the rejection of claims 11-12 and 18-22 should be withdrawn for at least the same reasons given above with respect to claims 10 and 17.

Claim 13 has been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Boyer et al. and further in view of U.S. Patent No. 5,638,523 (Mullet et al.). Applicant respectfully traverses this rejection and requests reconsideration because nothing in Boyer et al. or Mullet et al., taken alone, or together, discloses or renders obvious the invention of claim 13.

The Office Action merely relies on Mullet et al. for its teaching of an interactive map to receive a “proximate area having a circular shape surrounding a point on the map.” Office Action at 5. Nothing in the Office Action relies on Mullet et al. to cure the deficiencies noted above with respect to claim 10. For at least this reason, Applicant respectfully submits that the rejection of claim 13 is in error and should be withdrawn for at least the reasons given above with respect to claim 10.

Claims 14-16, 23-25 and 28 have been rejected under 35 U.S.C. § 103(a) as being obvious over Boyer et al. in view of the article entitled, "Address Matching, GIS Technology For Mapping Human Activity Patterns," published in the Journal of the American Planning Association, by William Drummond (Drummond). Applicant respectfully traverses this rejection and respectfully requests reconsideration because nothing in the prior art references taken alone, or in combination, teaches the unique subject matter claimed.

The Office Action admits that Boyer et al. "fail[s] to show geocoding the location input as recited in the claims." Office Action at 6. The Office Action, however, relies on Drummond for its teaching of "the step of geocoding the location-input received" (citing Drummond at 2). Office Action at 6. In concluding that the claimed subject matter would have been obvious over Boyer et al. in view of Drummond the Office Action states:

It would have been obvious to one of ordinary skill in the art, having the teachings of Boyer and Drummond before him at the time the invention was made, to modify the presentation or question information and map input response taught by Boyer to include the alphanumeric textual input location information of Drummond, in order to obtain a textual input for the location information to be input to the system.

Office Action at 6. The asserted motivation for modifying Boyer et al. with Drummond was "because a standardized location matching system would have been obtained, as taught by Drummond." Office Action at 6-7. Much like it appears, this reasoning is circular and improper in that Drummond specifically teaches a "standardized location matching system" and the purported motivation is to obtain that very "standardized location matching system." Nothing in Drummond, Boyer et al., or any other prior art

reference cited teaches or suggests that one of ordinary skill in the art would have desired to improve Boyer et al. by adding such a “standardized location system.”

Indeed, Boyer et al. would have no way of utilizing the system of Drummond. Boyer et al. allows the text entry of a zip code (column 6, lines 63-65) or the graphical entry of a geographic region within a state (column 7, lines 5-16) in order to identify a desired cable provider as stored in data server 14 (Fig. 1). The data server in Boyer et al. merely stores program listings for various cable and satellite providers. There is no indication (and there is no logical reason) that the system stores any street addresses.

The lack of street addresses in Drummond is significant because Drummond is solely directed to the technique of “address matching” for geographic information systems (GIS). As specifically taught in Drummond, “Address matching . . . convert[s] any administrative, survey, or business database with street addresses into a GIS database containing locational information.” Drummond at 240. Thus, any combination of Boyer et al. and Drummond would be inoperable. Moreover, Drummond explains that GIS is used by “urban planners [to] conduct environmental analyses, register parcel boundaries, map infrastructure locations, and model transportation systems.” Id. Because Boyer et al. has absolutely nothing to do with any of such urban planning activities, there is no reason one of ordinary skill in the art would have been drawn to the “address matching” technique of Drummond to improve upon the system of Boyer et al.

For at least these reasons, the rejection of claims 14-16, 23-25 and 28 is in error and should be withdrawn.

Claims 26 and 27 have been rejected under 35 U.S.C. § 103(a) as being obvious over Boyer et al. in view of Drummond, and further in view of U.S. Patent No. 6,604,083 (Bailey). Applicant respectfully traverses this rejection and respectfully requests reconsideration because nothing in the prior art references taken alone, or in combination, teaches the unique subject matter claimed.

As noted above with respect to the rejection of claims 14-16, 23-25 and 28, there is no motivation for combining the teachings of Drummond with Boyer et al. For this reason alone, the rejection of claims 26 and 27 based on this combination is in error and should be withdrawn, as noted above.

Nothing in Bailey cures this deficiency. Bailey is merely relied upon to show the feature of highlighting the selection of an input region. Nothing in the Office Action even recognizes the inability to combine Drummond and Boyer et al.

Applicant therefore respectfully requests that the rejection of claims 26 and 27 be reconsidered and withdrawn.

Applicant notes that claim 29 was not rejected over any prior art. Applicant respectfully requests therefore that claim 29 be indicated as allowable in the next Office Action. Should claim 29 be deemed anything other than allowable over the prior art, Applicant respectfully requests that the next Office Action be made non-final so that Applicant has a full and fair opportunity to be heard on the issues prior to appeal.

For at least the foregoing reasons, Applicant respectfully requests reconsideration of the application and earnestly solicit that the application be passed to issue with claims 10-29.

Applicant hereby petitions for any extension of time which may be necessary to have this Amendment considered. Applicant hereby authorizes the Director to debit our Account No. 04-1073 (under Order No. K1625.0002/P002-A) for any fees deemed necessary for that purpose.

Dated: September 13, 2005

Respectfully submitted,

By 

Eric Oliver

Registration No.: 35,307

DICKSTEIN SHAPIRO MORIN &  
OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorney for Applicant